

REMARKS/ARGUMENTS

Claims 1-12 were pending in this application. The rejections of claims 1-4, 6-11 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,710,900 to Anand, *et al.* (hereinafter “Anand”) in view of U.S. Patent No. 6,064,987 to Walker (hereinafter “Walker”) were withdrawn in view of the amendment. The rejections of claims 5 and 12 under 36 U.S.C. 103(a) as being unpatentable over Anand in view of Walker and further in view of the cited portions of U.S. Patent No. 5,930,764 to Melchione, *et al.* (hereinafter “Melchione”) were withdrawn in view of the amendment. No claims have been amended, added, or canceled. Hence, claims 1-12 remain pending. Reconsideration of the subject application is respectfully requested.

Claims 1-4, and 6-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anand in view of cited portions of U.S. Patent No. 5,425,102 to Moy, *et al.* (hereinafter “Moy”).

Claims 5 and 12, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anand in view of Moy as applied to claims 1 and 8 above, and further in view of Melchione.

Claim Rejections Under 35 U.S.C. § 103(a)

The Applicants respectfully traverse the rejection of all claims because the office action has not established a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

(MPEP § 2143) Here, the office action has not met all three criteria. Specifically, the office action has not shown that the prior art teaches or suggests all the claim limitations, and the office

action does not cite a reference that teaches or suggests a motivation to combine reference teachings.

With respect to claim 1, the office action correctly states that, “Anand does not disclose relating data maintained independently from the host site and input by a user with the user’s billing and inventory data for display as part of a requested report, wherein at least a portion of the data maintained independently from the host computer site and input by the user is displayed as part of the requested report.” The office action states that this teaching would have been obvious in light of Moy’s teachings relating to password hints. However, Moy does not teach or suggest all of this, thus negating a *prima facie* case of obviousness.

First, Moy does not suggest that the password hints may be a part of a report. To reason otherwise would be counterintuitive. Password hints help users remember their password, which, it is well known, is needed to access the functional parts of a system. Providing password hints in reports makes no sense because a user who is able to access the reports feature has already entered his password. Further, putting password hints in a report lessens the utility of the report since the password hints may help others to guess a user’s password. Thus, the user would not be able to show the report to others.

Second, Moy does not teach that the password hints are necessarily maintained independently from the host site. While they could be, neither Moy nor Anand teach that this is necessarily the case.

Third, Moy teaches nothing about relating password hints with other data nor putting the password hints in a report. “Relating,” when used in the context of the Applicant’s claimed invention, means more than simply outputting the data to the same report. Moy, however, does not even teach outputting to a report. Thus, for these reasons, the office action has not satisfied the third prong of the test because the cited references do not teach all the claim limitations.

Further, the office action does not cite a reference in the prior art that provides the necessary motivation or suggestion to combine the teachings of Anand with those of Moy to achieve the Applicant’s claimed invention. The Applicants notes that,

[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

(MPEP § 2143.01) However,

[t]he examiner may take official notice of facts outside the record which are capable of instant and unquestionable demonstration as being well-known in the art. ... If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that official notice can be taken, it is sufficient so to state. ... If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts **must be supported, when called for by the applicant, by an affidavit** from the examiner.

(MPEP § 2144.03, emphasis added, citing 37 CFR §1.104(d)(2)) Because no reference is cited that provides the teaching, suggestion, or motivation to combine the references, the Applicants assume the office action is relying on facts within the personal knowledge of the Examiner. The Applicants, therefore, respectfully traverse the rejection and request either an express showing of documentary proof, or an affidavit specifically stating the facts within the personal knowledge of the Examiner, as required by 37 CFR §1.104(d)(2).

Further, the references are unrelated. A password system as taught by Moy has nothing to do with a billing and inventory system. Although the two could exist in the same system, combining them functionally is not reasonable.

More importantly, however, the cited references teach away from what the office action has suggested. As stated above, putting passwords or password hints in reports has no utility. A user who has accessed the reports feature is beyond the point of needing help with a password. Further, putting passwords or password hints in a report would diminish the report's usefulness. Users don't want to share their passwords or password hints with others, although they often want to share reports with others. To include password hints in reports lessens the utility of the reports.

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PATENT

For all of the above reasons, the Applicants believe that claim 1 is allowable over the cited references. Further, claim 8 includes similar limitations and is believed to be allowable for similar reasons. Since the remaining claims depend from one of these independent claims, the Applicants believe that the remaining claims also are patentable.

CONCLUSION

In view of the foregoing, the Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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